

REMARKS/ARGUMENTS

Claims 1, 3-5, and 7-20 remain pending. Favorable reconsideration is respectfully requested.

Applicants would like to thank Examiner Tran for the helpful and courteous discussion held with their representative on May 2, 2003. During the discussion, Applicants' representative pointed out that Claims 2 and 6 do not embrace two different statutory classes. Claims 1 and 5, from which Claims 2 and 6 depend, are both directed to a hollow glass microsphere. Claims 2 and 6 further specify that the microsphere has an eluted amount of boron, where the method for determining the eluted amount of boron is set forth in the claims. Applicants also pointed out that the cited references certainly fail to describe or suggest the subject matter recited in Claims 2 and 6. The Examiner agreed that incorporating the subject matter of Claims 2 and 6 into Claims 1 and 5, respectively, may overcome the rejection.

In the amendment submitted above, the subject matter of Claims 2 and 6 has been incorporated into Claims 1 and 5, respectively.

The rejections of Claims 2-4 and 6 under 35 U.S.C. §101, §112, first paragraph, and §112, second paragraph are respectfully traversed. As discussed above, Claims 2-4 and 6 do not embrace two different statutory classes. Claims 1 and 5, from which Claims 2 and 6 depend, are both directed to a hollow glass microsphere. Claims 2 and 6 further specify that the microsphere has an eluted amount of boron, where the method for determining the eluted amount of boron is set forth in the claims. Therefore, the steps set forth in amended Claims 1 and 5 comprise, essentially, a test that characterizes a microsphere which is within the scope of those claims. One skilled in the art reading the claims in light of the specification will appreciate the metes and bounds of the claims.

Based on the foregoing, the pending claims satisfy the requirements of 5 U.S.C. §101, §112, first paragraph, and §112, second paragraph. Accordingly, withdrawal of these grounds of rejection is respectfully requested.

The obviousness-type double patenting rejections set forth in the Official Action dated March 21, 2003 are respectfully traversed.

U.S. application serial No. 09/858,571 is abandoned. The claims of U.S. patent No. 6,531,222 do not disclose or suggest, *inter alia*, the eluted amount of boron recited in the claims of the present application. Accordingly, withdrawal of this ground of rejection is respectfully requested.

The rejection of Claims 1-4 under 35 U.S.C. §102(b) over Kawachi is respectfully traversed. Kawachi fails to describe the glass microsphere recited in amended Claim 1.

Kawachi fails to describe that the glass bubbles described therein have an eluted amount of boron is at most 300 ppm of a sample mass amount as measured as described in Claim 1. Therefore, Kawachi fails to describe the claimed glass microsphere. Accordingly, withdrawal of this ground of rejection is respectfully requested.

The rejection of Claims 1-20 under 35 U.S.C. §103(a) over Aria et al. as evidenced by Kawachi is respectfully traversed. Those references fail to suggest the claimed glass microspheres.

Amended Claim 1 specifies that the glass microspheres have an eluted amount of boron measured by the following method is at most 300 ppm of a sample mass amount as measured as described in the claim. Aria et al. fail to describe such a feature. Nor does the reference suggest this property. Kawachi, as discussed above, also fails to describe an eluted amount of boron. Nor does that reference suggest that property. Therefore, the glass microsphere recited in amended Claim 1 is not suggested by Aria et al. as evidenced by

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Kawachi. Accordingly, Claims 1, 3-5, and 7-20 are not obvious over those references.

Withdrawal of this ground of rejection is respectfully requested.

Applicants submit that the present application is in condition for allowance. Early notice to this effect is earnestly solicited.

Respectfully submitted,

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